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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/535,142 | 05/17/2005 | Go Mizutani | 441P094 | 5678 |
| 42754 7590 03/28/2007 NIELDS & LEMACK 176 EAST MAIN STREET, SUITE 7 WESTBORO, MA 01581 | | | EXAMINER BERNSHTEYN, MICHAEL | |
| | | | ART UNIT 1713 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 03/28/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/535,142

Applicant(s)

MIZUTANI ET AL.

Examiner

Michael Bernshteyn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action follows a response filed on January 16, 2007. No claims have been amended, added or cancelled.
2. Claims 1-3, 5-7 and 9 are pending.

Claim Rejections - 35 USC § 103

3. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
4. Claims 1-3, 5-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Ishii et al. (JP 08-194968) in view of Tokuda et al. (JP 2002-092961), for rationale recited in paragraph 4 of Office Action dated on October 24, 2006.

Response to Arguments

5. Applicants traverse the rejection of claims 1-3, 5-7 and 9 under 35 U.S.C. 103(a) as being unpatentable as obvious over Ishii et al. (JP 08-194968) in view of Tokuda et al. (JP 2002-092961). Applicant's arguments filed on January 16, 2007 have been fully considered but they are not persuasive.
6. Applicants contend that the coating agent shown in the working example of Ishii comprises component (A) (EPA-I), IRGACURE 651, component (E) (MANDA: hydroxypivalic acid neopentyl glycol diacrylate), component (C) (TC-101: tetrahydrofurfuryl acrylate) and a photopolymerization initiator, that are essential components of the present invention. However, Ishii does not disclose or suggest the

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addition of component (D) ((meth)acrylate phosphate compound) which is also an essential component of the present invention, and the working examples of Ishii do not comprise the component (D). Accordingly, Ishii does not disclose or suggest the present invention as claimed. Furthermore, Ishii does not disclose or suggest bonding the optical discs, nor the avoidance of the generation of voids during the manufacturing process of the disc, nor the electrical resistivity of the optical discs.

Tokuda does not supply the above deficiencies of Ishii. Tokuda is related to the adhesive for optical discs having a reflection film comprising silver or silver alloy, comprising urethane (meth)acrylate as an essential component, whereas the instant claims exclude urethane (meth)acrylate. Furthermore, Tokuda does not recite the avoidance of the generation of voids during the manufacturing process of the disc or the electrical resistivity of the optical discs.

Thus, the combination of Ishii and Tokuda does not suggest the instant as invention as claimed. Furthermore, neither reference discloses or suggests the advantageous effects of the present invention. Ishii does not show the advantageous effects as an adhesive, and neither reference shows the unexpected effects of no void generation during the manufacturing process of the optical disc having a reflection film comprising silver or silver alloy, of imparting durability similar to an optical disc having a reflection film comprising gold, and of providing an optical disc having the reflection film comprising silver or silver alloy with low electric resistivity (Examples 1-4) (pages 2-3).

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is further noted that "The motivation in the prior art to combine references does not have to be identical to that of the applicant to establish obviousness, i.e. it is not required for a finding of obviousness that motivation of the skilled artisan be the same as an applicant motivation", *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1312 (Fed. Cir. 1996) (holding there is sufficient motivation to combine teachings of prior art to achieve claimed invention where one reference specifically refers to the other).

Therefore, it is well settled that for a finding of obviousness under § 103 the prior art need not disclose the same motivation as disclosed by an applicant.

8. In response to applicant's arguments, the recitation that Ishii does not disclose or suggest bonding the optical discs has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

9. It is noted that as it was mentioned in paragraph 4 of Office Action dated on June 22, 2006, Tokuda clearly discloses the usage of (meth) acrylate phosphate compounds,

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such as ethylene oxide modified phenoxide (meth)acrylate phosphate, ethylene oxide modified butoxide (meth)acrylate phosphate, etc.

Both references are analogous art because they are from the same field of endeavor concerning new adhesive compositions for optical disk.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate meth) acrylate phosphate compounds as taught by Tokuda in Ishii's adhesive composition with reasonable expectation of success because these compounds were successfully used in order to obtain an adhesive, which can impart durability and hardened material thereof in a sticking type optical disk having a semitransparent reflecting film (JP'961, abstract), and thus to arrive at the subject matter of instant claim 1.

With regard to the limitations of claim 6, Tokuda discloses that UV-curable resin composition has an electrical resistivity in the range 380-520 mPa.S/25°C, which is within the claimed range (Example 1-6, page 5, [0022]).

10. Furthermore it is noted that Ishii discloses the protective coating agent for an optical disc, which is produced by coating the memory part of the optical disc with a radiation curing resin composition. The composition of the protective coating agent for the optical disc contains more than one (meth) acrylate, i.e., monofunctional monomer or oligomer, in a molecule (abstract).

Ishii does not disclose that a total reflection film or a translucent reflection film comprising silver or a silver alloy.

Tokuda discloses that UV-curable resin composition used like adhesive, which can impart high durability and hardened material thereof in a sticking type optical disk having a semitransparent effecting film in which the semitransparent reflecting film of one disk substrate comprises a silver compound or an alloy thereof when two sheets of the disk substrates are stuck together by the adhesive for optical disk (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a **silver compound or an alloy** thereof when two sheets of the disk substrates are stuck together by the adhesive for optical disk as taught by Tokuda in Ishii's adhesive composition in order to obtain an adhesive, which can impart durability and hardened material thereof in a sticking type optical disk having a semitransparent reflecting film (JP'961, abstract).

11. It is worth to mention that Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teaching in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, **to fully consider the references in entirety as potentially teaching all or part of the claimed invention**, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Bernshteyn
Patent Examiner
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03/22/2007


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